UNITED STATES PATENT AND TRADEMARK OFFICE

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EXAMINER
LEE, JINHEE J

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *23 April 2008*.
2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-15* is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) *1-15* is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a) ☐ All   b) ☐ Some * c) ☐ None of:
        1. ☐ Certified copies of the priority documents have been received.
        2. ☐ Certified copies of the priority documents have been received in Application No. _____.
        3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date ___.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____ .

DETAILED ACTION

Claim Rejections - 35 USC § 101

1.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2.   Claims 11-15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Re claims 11-15, claims 11-15 fails to fall within a statutory category of invention. They are directed to a program itself, not a process occurring as a result of executing the program, a machine programmed to operate in accordance with the program nor a manufacture structurally and functionally interconnected with the program in a manner which enables the program to act as a computer component and realize its functionality. They are also clearly not directed to a composition of matter. Therefore, they are non-statutory under 32 USC 101.

Claims 6-10 meet the 101 requirements, due to the use of memory (which is hardware).

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4.   Claims 1-3, 5-8, 10-13 and 15,9 and 14 are rejected under 35 U.S.C. 103(a) as

being unpatentable over SAP Wizard Builder (NPL provided by the applicant in IDS

called Screen Shots of a Wizard Builder sold by SAP AG, 7 sheets).

Re claim 1, SAP Wizard Builder substantially discloses a method to be executed

as part of a process for creating an executable configuration program that comprises

multiple steps that are successively executed and wherein associated with each of the

steps are user-selectable options, the method comprising: creating a rule that during

execution of the configuration program determines which of the user-selectable options

for a step are displayed when a specified user-selectable option of a previous step is

selected; and binding the rule to the specified user selectable option so that during

execution of the configuration program the rule is executed when the specified user-

selectable option is selected (rule created and binded to execute the rule binded to the

specific option when user selects the user-selectable option as claimed above is shown

in figures 4-7 for example, also see annotation in figure below). SAP Wizard Builder

does not explicitly disclose storing the rule in a repository and binding it in the

repository. It would have been an obvious matter of design choice to store and bind the

rule in the repository, since such a modification would have involved the mere

application of a known technique such as storing programming to a piece of prior art

ready for improvement. Where a claimed improvement on a device or apparatus is no

more than "the simple substitution of one known element for another or the mere

application of a known technique to a piece of prior art ready for improvement," the

claim is unpatentable under 35 U.S.C. 103(a). Ex Parte Smith, 83 USPQ.2d 1509,

1518-19 (BPAI, 2007) (citing KSR v. Teleflex, 127 S.Ct. 1727, 1740, 82 USPQ2d 1385, 1396 (2007)). Accordingly Applicant claims a combination that only unites old elements with no change in the respective functions of those old elements, and the combination of those elements yields predictable results; absent evidence that the modifications necessary to effect the combination of elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C. 103(a). Ex Parte Smith, 83 USPQ.2d at 1518-19 (BPAI, 2007) (citing KSR, 127 S.Ct. at 1740, 82 USPQ2d at1396.

Re claim 2, note that SAP Wizard Builder discloses a method wherein the binding of the rule to the specified user-selectable option is performed by virtue of a designer selecting a user-selectable option for which to create the rule (inherent, since pages 4-7 show that the user-selectable options are set as created by the designer).

Re claim 3, SAP Wizard Builder substantially discloses a method further comprising: creating a textual explanation of the step that describes available user-selectable options for the step; and binding the textual explanation to the step so that during execution of the configuration program the textual explanation of the step is displayed (see annotated figure below for example). SAP Wizard Builder does not explicitly disclose storing the textual explanation in a repository and binding it in the repository. It would have been an obvious matter of design choice to store and bind the textual explanation in the repository, since such a modification would have involved the mere application of a known technique such as storing programming to a piece of prior art ready for improvement. Where a claimed improvement on a device or apparatus is

no more than "the simple substitution of one known element for another or the mere

application of a known technique to a piece of prior art ready for improvement," the

claim is unpatentable under 35 U.S.C. 103(a). Ex Parte Smith, 83 USPQ.2d 1509,

1518-19 (BPAI, 2007) (citing KSR v. Teleflex, 127 S.Ct. 1727, 1740, 82 USPQ2d 1385,

1396 (2007)). Accordingly Applicant claims a combination that only unites old elements

with no change in the respective functions of those old elements, and the combination

of those elements yields predictable results; absent evidence that the modifications

necessary to effect the combination of elements is uniquely challenging or difficult for

one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C.

103(a). Ex Parte Smith, 83 USPQ.2d at 1518-19 (BPAI, 2007) (citing KSR, 127 S.Ct.

at 1740, 82 USPQ2d at1396.
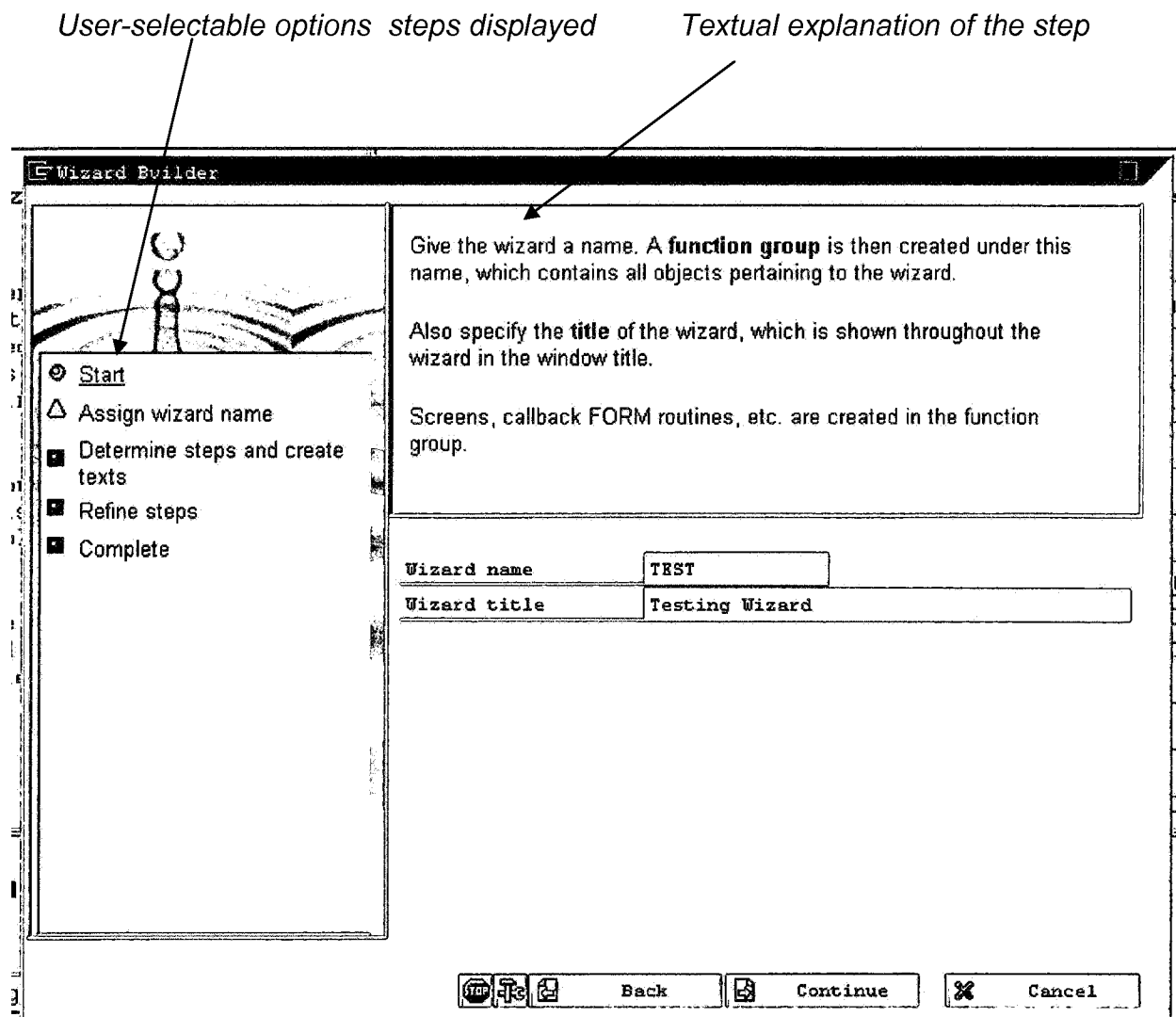
Re claim 5, note that SAP Wizard Builder discloses a method further comprising

evaluating the stability of a configured software application by executing the software

application using a simulated user-selectable option (see page 3, execute in diagnosis

mode for example).

User-selectable options steps displayed   *Textual explanation of the step*

```
┌─Wizard Builder ─────────────────────────────────────────────────────────┐
│                                                                          │
│    ( )           Give the wizard a name. A function group is then created under this │
│     |            name, which contains all objects pertaining to the wizard.         │
│     |                                                                     │
│     |            Also specify the title of the wizard, which is shown throughout the │
│  ⊘ Start         wizard in the window title.                             │
│  △ Assign wizard name                                                    │
│  ▣ Determine steps and create    Screens, callback FORM routines, etc. are created in the function │
│    texts         group.                                                  │
│  ▣ Refine steps                                                          │
│  ▣ Complete                                                              │
│                  ┌──────────────────────────────────────────────────┐   │
│                  │ Wizard name      │ TEST                    │       │   │
│                  │ Wizard title     │ Testing Wizard          │       │   │
│                  └──────────────────────────────────────────────────┘   │
│                                                                          │
│                       Back  │  Continue  │  Cancel                      │
└──────────────────────────────────────────────────────────────────────────┘
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Re claim 6, SAP Wizard Builder substantially discloses a system comprising: a

computer network (inherently used to execute the wizard builder); a service delivery

device coupled to the network, the service delivery device including a processor and

memory storing instructions that, in response to receiving a first type of request for

access to a service (inherently used to execute the wizard builder), cause the processor

to: create an executable configuration program that comprises multiple steps that are

successively executed and wherein associated with each of the steps are user-

selectable options; create a rule that during execution of the configuration program determines which of the user-selectable options for a step are displayed when a specified user-selectable option of a previous step is selected; and bind the rule to the specified user- selectable option so that during execution of the configuration program the rule is executed when the specified user-selectable option is selected (rule created and binded to execute the rule binded to the specific option when user selects the user-selectable option as claimed above is shown in figures 4-7 for example, also see annotation in figure above). SAP Wizard Builder does not explicitly disclose storing the rule in a repository and binding it in the repository. It would have been an obvious matter of design choice to store and bind the rule in the repository, since such a modification would have involved the mere application of a known technique such as storing programming to a piece of prior art ready for improvement. Where a claimed improvement on a device or apparatus is no more than "the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for improvement," the claim is unpatentable under 35 U.S.C. 103(a). Ex Parte Smith, 83 USPQ.2d 1509, 1518-19 (BPAI, 2007) (citing KSR v. Teleflex, 127 S.Ct. 1727, 1740, 82 USPQ2d 1385, 1396 (2007)). Accordingly Applicant claims a combination that only unites old elements with no change in the respective functions of those old elements, and the combination of those elements yields predictable results; absent evidence that the modifications necessary to effect the combination of elements is uniquely challenging or difficult for one of ordinary skill in the art, the claim is

unpatentable as obvious under 35 U.S.C. 103(a). Ex Parte Smith, 83 USPQ.2d at

1518-19 (BPAI, 2007) (citing KSR, 127 S.Ct. at 1740, 82 USPQ2d at1396.

Re claim 7, note that SAP Wizard Builder discloses a system wherein the

memory stores instructions that, in response to receiving the first type of request, cause

the processor to bind the rule to the specified user-selectable option by providing an

ability to select a user-selectable option for which to create the rule (rule created and

binded to execute the rule binded to the specific option when user selects the user-

selectable option as claimed above is shown in figures 4-7 for example, also see

annotation in figure above).

Re claim 8, SAP Wizard Builder substantially discloses a system wherein the

memory stores instructions that, in response to receiving the first type of request, cause

the processor to: create a textual explanation of the step that describes available user-

selectable options for the step; and bind the textual explanation to the step so that

during execution of the configuration program the textual explanation of the step is

displayed (see annotated figure above for example). SAP Wizard Builder does not

explicitly disclose storing the textual explanation in a repository and binding it in the

repository. It would have been an obvious matter of design choice to store and bind the

textual explanation in the repository, since such a modification would have involved the

mere application of a known technique such as storing programming to a piece of prior

art ready for improvement. Where a claimed improvement on a device or apparatus is

no more than "the simple substitution of one known element for another or the mere

application of a known technique to a piece of prior art ready for improvement," the

claim is unpatentable under 35 U.S.C. 103(a). Ex Parte Smith, 83 USPQ.2d 1509,

1518-19 (BPAI, 2007) (citing KSR v. Teleflex, 127 S.Ct. 1727, 1740, 82 USPQ2d 1385,

1396 (2007)). Accordingly Applicant claims a combination that only unites old elements

with no change in the respective functions of those old elements, and the combination

of those elements yields predictable results; absent evidence that the modifications

necessary to effect the combination of elements is uniquely challenging or difficult for

one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C.

103(a). Ex Parte Smith, 83 USPQ.2d at 1518-19 (BPAI, 2007) (citing KSR, 127 S.Ct.

at 1740, 82 USPQ2d at1396.

Re claim 10, note that SAP Wizard Builder discloses a system wherein the

memory stores instructions that, in response to receiving the first type of request, cause

the processor to evaluate the stability of a configured software application by executing

the software application using a simulated user-selectable option (see page 3, diagnosis

mode for example).

Re claim 11, SAP Wizard Builder substantially discloses an article comprising a

machine-readable medium storing machine-readable instructions (inherently used for

displaying and using the Wizard Builder) that, when applied to the machine, cause the

machine to: create an executable configuration program that comprises multiple steps

that are successively executed and wherein associated with each of the steps are user-

selectable options; create a rule that during execution of the configuration program

determines which of the user-selectable options for a step are displayed when a

specified user-selectable option of a previous step is selected; and bind the rule to the

specified user-selectable option so that during execution of the configuration program

the rule is executed when the specified user-selectable option is selected (rule created

and binded to execute the rule binded to the specific option when user selects the user-

selectable option as claimed above is shown in figures 4-7 for example, also see

annotation in figure above). SAP Wizard Builder does not explicitly disclose storing the

rule in a repository and binding it in the repository. It would have been an obvious

matter of design choice to store and bind the rule in the repository, since such a

modification would have involved the mere application of a known technique such as

storing programming to a piece of prior art ready for improvement. Where a claimed

improvement on a device or apparatus is no more than "the simple substitution of one

known element for another or the mere application of a known technique to a piece of

prior art ready for improvement," the claim is unpatentable under 35 U.S.C. 103(a). Ex

Parte Smith, 83 USPQ.2d 1509, 1518-19 (BPAI, 2007) (citing KSR v. Teleflex, 127

S.Ct. 1727, 1740, 82 USPQ2d 1385, 1396 (2007)). Accordingly Applicant claims a

combination that only unites old elements with no change in the respective functions of

those old elements, and the combination of those elements yields predictable results;

absent evidence that the modifications necessary to effect the combination of elements

is uniquely challenging or difficult for one of ordinary skill in the art, the claim is

unpatentable as obvious under 35 U.S.C. 103(a). Ex Parte Smith, 83 USPQ.2d at

1518-19 (BPAI, 2007) (citing KSR, 127 S.Ct. at 1740, 82 USPQ2d at1396.

Re claim 12, note that SAP Wizard Builder discloses an article including

instructions that, when applied to the machine, cause the machine to bind the rule to the

specified user-selectable option by providing an ability to select a user-selectable option

for which to create the rule (see pages 4-7 for example).

Re claim 13, SAP Wizard Builder substantially discloses an article including

instructions that, when applied to the machine, cause the machine to: create a textual

explanation of the step that describes available user-selectable options for the step;

and bind the textual explanation to the step so that during execution of the configuration

program the textual explanation of the step is displayed (see annotated figure above for

example). SAP Wizard Builder does not explicitly disclose storing the textual

explanation in a repository and binding it in the repository. It would have been an

obvious matter of design choice to store and bind the textual explanation in the

repository, since such a modification would have involved the mere application of a

known technique such as storing programming to a piece of prior art ready for

improvement. Where a claimed improvement on a device or apparatus is no more than

"the simple substitution of one known element for another or the mere application of a

known technique to a piece of prior art ready for improvement," the claim is

unpatentable under 35 U.S.C. 103(a). Ex Parte Smith, 83 USPQ.2d 1509, 1518-19

(BPAI, 2007) (citing KSR v. Teleflex, 127 S.Ct. 1727, 1740, 82 USPQ2d 1385, 1396

(2007)). Accordingly Applicant claims a combination that only unites old elements with

no change in the respective functions of those old elements, and the combination of

those elements yields predictable results; absent evidence that the modifications

necessary to effect the combination of elements is uniquely challenging or difficult for

one of ordinary skill in the art, the claim is unpatentable as obvious under 35 U.S.C.

103(a). Ex Parte Smith, 83 USPQ.2d at 1518-19 (BPAI, 2007) (citing KSR, 127 S.Ct.
at 1740, 82 USPQ2d at1396.

Re claim 15, note that SAP Wizard Builder discloses an article including
instructions that, when applied to the machine, cause the machine to evaluate the
stability of a configured software application by executing the software application using
a simulated user-selectable option (see page 3, diagnosis mode for example).

5.   Claims 4,9 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable
over SAP Wizard Builder in view of Watson-Luke et al. (20050114240).

Re claim 4, SAP Wizard Builder substantially discloses a method as set forth in
claim 3 above SAP Wizard Builder does not explicitly disclose wherein creating the
textual explanation comprises translating the textual explanation into at least one
different language. However, Watson-Luke et al. teaches of wherein creating the
textual explanation comprises translating the textual explanation into at least one
different language (see paragraph 0297 for example). It would have been obvious to
one having ordinary skill in the art at the time the invention was made to have wherein
creating the textual explanation comprises translating the textual explanation into at
least one different language of Watson-Luke et al. on the method of SAP Wizard Builder
in order to provide different language support.

Re claim 9, SAP Wizard Builder substantially discloses a system as set forth in
claim 8 above SAP Wizard Builder does not explicitly disclose wherein the memory
stores instructions that, in response to receiving the first type of request, cause the
processor to translate the textual explanation into at least one different language.

However, Watson-Luke et al. teaches of wherein the memory stores instructions that, in response to receiving the first type of request, cause the processor to translate the textual explanation into at least one different language (see paragraph 0297 for example). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have wherein the memory stores instructions that, in response to receiving the first type of request, cause the processor to translate the textual explanation into at least one different language of Watson-Luke et al. on the system of SAP Wizard Builder in order to provide different language support.

Re claim 14, SAP Wizard Builder substantially discloses an article as set forth in claim 13 above SAP Wizard Builder does not explicitly disclose when applied to the machine, cause the machine to translate the textual explanation into at least one different language. However, Watson-Luke et al. teaches of when applied to the machine, cause the machine to translate the textual explanation into at least one different language (see paragraph 0297 for example). It would have been obvious to one having ordinary skill in the art at the time the invention was made to have when applied to the machine, cause the machine to translate the textual explanation into at least one different language of Watson-Luke et al. on the article of SAP Wizard Builder in order to provide different language support.

Response to Arguments

6.   Applicant's arguments with respect to claims 1-15 have been considered but are moot in view of the new ground(s) of rejection.

7.   In response to applicant's arguments regarding the 101 rejection, examiner has

maintained the rejection for the product claims of 11-15, since it is unclear if the storage

repository is a hardware or software. The repository seems to be used as software in

figure 2 when referring to the text repository (it is a part of the software program).

        In response to applicant's arguments that the SAP Wizard Builder does not teach

user created rules, examiner disagrees. In the "Determine steps and create texts"

option, the user creates steps using options as specified by the user. In the figure

showing this step, creating and binding of rules (steps, in the figure) can be seen in the

"roadmap" for example). i.e. determining steps is creating rules and creating texts is

creating textual explanation.

Conclusion

8.   Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

        A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jinhee J. Lee whose telephone number is 571-272-1977. The examiner can normally be reached on M-F at 8:30AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Bashore can be reached on 571-272-2100 ext. 75. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jinhee J Lee/
Primary Examiner, Art Unit 2175

jjl